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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,265	01/21/2004	Kia Silverbrook	SMA10US	1040

24011 7590 03/27/2008
SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

ANTONIENKO, DEBRA L

ART UNIT	PAPER NUMBER
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4194

MAIL DATE	DELIVERY MODE
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03/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/760,265	Applicant(s) SILVERBROOK ET AL.	
	Examiner DEBRA ANTONIENKO	Art Unit 4194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/03/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the application filed on January 21, 2004.
2. Claims 1-11 are currently pending.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on November 3, 2004 has been considered by the Examiner.

Specification

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The abstract of the disclosure is objected to because of the use of "comprising", legal phraseology. Appropriate correction is required. See MPEP § 608.01(b).
6. The disclosure is objected to because of the following informalities: docket numbers are listed for co-pending applications. U.S. Application Numbers should be used. Appropriate correction is required.

Drawings

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “217” has been used to designate both Input Source(s) in Figure 1 and 4-plane contone buffer in Figure 30. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

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double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of U.S. Patent No. 7,002,664 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 1 of U.S. Patent No. 7,002,664 B2 recites the elements of Claim 1 in the present application.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 3 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention (i.e., a process, machine, manufacture, or composition of matter). In the present case, Claim 3 is directed to a franchise (i.e., a license or permission or an agreement). Permission or an agreement to do something is an abstract idea which is not considered to be patentable subject matter.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. In Claim 1, the phrase “in a manner” renders the limitation vague and indefinite.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto et al., U.S. Patent Number 5,974,401 (hereinafter referred to as Enomoto) in view of Wen, U.S. Patent Number 6,109,745 (hereinafter referred to as Wen).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

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Regarding Claim 1:

Enomoto teaches a method of operating a photofinishing business and which comprises utilizing a digital photofinishing system that incorporates a digital processor, a printer and means for feeding print media to the printer from a roll of the print media (column 2, lines 23-31; column 5, lines 8-12; Figure 2, element 31);

the digital processor being provided with digitised data from a source that is provided by a customer, and which is representative of a photographic image, and the data being processed in a manner to generate a printer drive signal that is representative of the photographic image (column 1, lines 54-67 and column 2, lines 1-5),

the printer being coupled to the digital processor and ... printing of the photographic image on the print media as it is fed directly to the printer from the roll (column 5, lines 8-18 and 42-44; Figure 2, element 31),

and the printed image being furnished to the customer who is charged for the printing service (column 2, lines 43-45).

Enomoto does not explicitly teach the drive signal being processed to effect page-width printing.

However, Wen does disclose the drive signal being processed to effect page-width printing (column 2, lines 35-38 and 44-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Enomoto's system to incorporate Wen's page-width printing in order to maximize the speed of printing.

17. Claims 2, 4-6, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Wen and further in view of Tanaka, U.S. Patent Number 6,196,493 (hereinafter referred to as Tanaka).

Regarding Claim 2:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Enomoto and Wen do not explicitly teach wherein the roll of print media is provided by way of a replaceable cartridge.

However, Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (column 4, lines 18-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Wen with that of Tanaka to incorporate a replaceable cartridge in order to facilitate installing and replacing the print media.

Regarding Claim 4:

Enomoto and Wen teach the limitations of Claim 1 as described above.

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Enomoto and Wen do not explicitly teach wherein the roll of print media is provided by way of a replaceable cartridge in which the cartridge is mounted removably in juxtaposition to the printer and comprises a roll of the print media to be fed on demand to the printer, and the cartridge incorporates means for coupling with a print media feed drive mechanism.

However, Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2) in which the cartridge is mounted removably in juxtaposition to the printer (column 5, lines 50-54; Figure 6, elements 10 and 30) and comprises a roll of the print media to be fed on demand to the printer, and the cartridge incorporates means for coupling with a print media feed drive mechanism (column 4, lines 32-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Wen with that of Tanaka to locate the print media next to the printer in order to minimize the transport time and exposure of print media before being printed.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Wen with that of Tanaka to incorporate a media feed drive mechanism in order to facilitate the printing process.

Regarding Claim 5:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Wen further teaches a source of printing fluid to be delivered on demand to the printer (column 2, lines 20-45). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Enomoto's system to incorporate Wen's supply of printing fluid in order to facilitate the printing process.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge in which the cartridge is mounted removably in juxtaposition to the printer ... and the cartridge incorporates means for coupling with a print media feed drive mechanism (see Claim 4).

Regarding Claim 6:

See Claims 4 and 5.

Regarding Claim 9:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Enomoto and Wen do not explicitly teach wherein the roll of print media is provided by way of a replaceable cartridge in which print media feed means are located in the cartridge and drive means couple with the print media feed means to effect feeding of the print media through the printer.

However, Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge in which print media feed means are located in the cartridge and drive means couple with the print media feed means to effect feeding of the print media through the printer (see Claim 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto and Wen with that of Tanaka to locate print media feed means in the cartridge in order to facilitate the printing process.

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18. Claims 7, 8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Wen in view of Tanaka and further in view of Janosky et al., U.S. Patent Number 6,394,669 (hereinafter referred to as Janosky).

Regarding Claim 7:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2).

Enomoto, Wen, and Tanaka do not explicitly teach in which a drier means is coupled to the printer and the drier means receives printed media directly from the printer, to transport the printed media from the printer and to effect drying of the printed media during transportation of the media.

However, Janosky discloses in which a drier means is coupled to the printer and the drier means receives printed media directly from the printer, to transport the printed media from the printer and to effect drying of the printed media during transportation of the media (column 7, lines 20-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto, Wen, and Tanaka with that of Janosky to incorporate a drier in order to facilitate the printing process.

Regarding Claim 8:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2).

Enomoto, Wen, and Tanaka do not explicitly teach in which a slitter means is located in series with the printer and the slitter means receives printed media following its passage through the printer, transports the printed media in a direction away from the printer and slits the printed media in the longitudinal direction of transportation of the media.

However, Janosky discloses in which a slitter means is located in series with the printer and the slitter means receives printed media following its passage through the printer, transports the printed media in a direction away from the printer and slits the printed media in the longitudinal direction of transportation of the media (column 8, lines 58-67; column 9, lines 1-2; Figure 5A).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto, Wen, and Tanaka with that of Janosky to incorporate a slitter in order to efficiently provide the required print size.

Regarding Claim 10:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2).

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Enomoto, Wen, and Tanaka do not explicitly teach in which means are provided to enable chemical development and subsequent printing of exposed photographic film.

However, Janosky discloses in which means are provided to enable chemical development and subsequent printing of exposed photographic film (column 3, lines 59-63).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto, Wen, and Tanaka with that of Janosky to provide development and printing of photographic film as well in order to accommodate customer needs.

19. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto in view of Wen in view of Tanaka and further in view of Silverbrook et al., U.S. Patent Number 6,612,240 (hereinafter referred to as Silverbrook).

Regarding Claim 11:

Enomoto and Wen teach the limitations of Claim 1 as described above.

Tanaka discloses wherein the roll of print media is provided by way of a replaceable cartridge (see Claim 2).

Enomoto, Wen, and Tanaka do not explicitly teach in which the printer incorporates at least one print head assembly that is arranged to provide for printing of the print media with a feed rate up to 2 metres per second.

However, Silverbrook discloses in which the printer incorporates at least one print head assembly that is arranged to provide for printing of the print media with a feed rate up to 2 metres per second (column 2, lines 7-9; Figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Enomoto, Wen, and Tanaka with that of Silverbrook to include a print head assembly and to determine the feed rate in order to facilitate the printing process.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is (571)270-3601. The examiner can normally be reached on Monday through Friday, 7:30 AM to 5:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Debra Antonienko/
Examiner, Art Unit 4194
03/24/2008

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 4194